

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-28, all of which have been rejected. Applicants have amended claims 1-2, 5-7, 9, 11-12, 14, 16-23, and 26 - 28 to further prosecution of the claims and to clarify the language used in these claims in light of the recent Federal Circuit decision in *SuperGuide Corp. v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004). Applicants do not believe that these amendments affect allowability of the claims.

Claims 1-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,795,205 issued to Gacek (hereinafter, Gacek). Claims 19-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US 20020135808 issued to Parry (hereinafter, Parry). Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Gacek.

Applicants request reconsideration of the claims in view of the amendments and the following remarks.

#### **Claim Rejections under 35 U.S.C. § 102**

(Paragraphs 2 and 4 of the Office Action)

Claims 1-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gacek. Claims 19-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Parry.

With regard to the anticipation rejections under Gacek, MPEP 2131 states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states that "[t]he identical

invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to the rejection of independent claim 1 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of “at least one communication device deployed in at least one location,” as claimed by Applicants in independent claim 1. The Office Action refers to items 102 and 103 in Figure 1 of Gacek as complying with the “at least one communication device” limitation disclosed by Applicants in claim 1 (Office Action, page 2). The Applicants respectfully traverse this assertion. More specifically, items 102 and 103 in Figure 1 of Gacek are “third-party merchants” and not communication devices in the context of Applicant’s invention and as claimed in claim 1.

Furthermore with regard to the rejection of independent claim 1 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of “the print server software resides within a media processing system (MPS), and wherein the MPS processes at least one of the following: television (TV) signals and radio signals received via the communication network,” as claimed by Applicants in independent claim 1. More specifically, Gacek discloses that the cable headend (CHE) 6 acts as the print server by routing and managing resources of the printers (Figure 2 of Gacek and pages 2-3 of the Office Action). However, Gacek does not disclose or suggest that the CHE 6 or the STB 10 comprise print server software that resides within a media processing system that is adapted to process television and/or radio signals, as disclosed by the Applicants in claim 1 and in the detailed description of the invention.

With regard to the rejection of independent claim 12 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of “a first communication device deployed at a first location,” as claimed by

Applicants in independent claim 12. The Office Action refers to item 102 in Figure 1 of Gacek as complying with this claim limitation of a first communication device disclosed by Applicants in claim 12 (Office Action, page 6). The Applicants respectfully traverse this assertion. More specifically, item 102 in Figure 1 of Gacek is a "third-party merchant" and not a communication device deployed at a first location, in the context of Applicant's invention and as claimed in claim 12.

Furthermore with regard to the rejection of independent claim 12 under Gacek, Applicants submit that Gacek does not disclose or suggest at least the limitation of "a second communication device deployed at a second location," as claimed by Applicants in independent claim 12. The Office Action refers to item 105 in Figure 1 of Gacek as complying with this claim limitation of a second communication device disclosed by Applicants in claim 12 (Office Action, page 6).

The Applicants respectfully traverse this assertion. More specifically, item 105 in Figure 1 of Gacek is a digital cable network and not a communication device deployed at a second location, in the context of Applicant's invention and as claimed in claim 12.

With regard to the rejection of independent claim 19 under Parry, Applicants submit that Parry does not disclose or suggest at least the limitation of "searching through a plurality of video frames on a communication network via a first communication device at a first location, the first communication device being communicatively coupled to at least a second communication device at a second location via the communication network," as claimed by Applicants in independent claim 19. Figure 3 of Parry teaches that the printer receives video information and stores the video information in printer memory (Parry, page 2, paragraph [0023]). In addition, the searching is performed only through the stored video information (Parry, page 2, paragraph [0025]), and not through "a plurality of video frames on a communication network," as claimed by Applicants in claim 19. In addition, Parry does not teach or disclose "a first communication device at a first location,

the first communication device being communicatively coupled to at least a second communication device at a second location,” as claimed by Applicants in claim 19.

Based on at least the foregoing, Applicants believe the rejection of independent claims 1 and 12 under 35 U.S.C. § 102(e) as being anticipated by Gacek has been overcome and request that the rejection be withdrawn. Based on at least the foregoing, Applicants also believe the rejection of independent claim 19 under 35 U.S.C. § 102(e) as being anticipated by Parry has been overcome and request that the rejection be withdrawn. Additionally, claims 2-11, 13-18, and 20-25 depend from independent claims 1, 12, 19, respectively, and are consequently also respectfully submitted to be allowable.

### **Claim Rejections under 35 U.S.C. § 103**

(Paragraph 6 of the Office Action)

Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Gacek.

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that

“although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *AI-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or suggest at least the limitation of “calling up printer resources available on the communication network using the communication device,” as claimed by Applicants in independent claim 26. Figure 2 of Gacek discloses how a print job can be sent from an internet application 15 through CPSI client 16 and IPP client 17 to IPP server 19 and on to CPSI server 37 (Gacek, col. 7, lines 49-52). In this regard, Gacek does not disclose “calling up printer resources available on the communication network using the communication device,” as claimed by Applicants in independent claim 26.

With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or suggest at least the limitation of “selecting a printer resource from the available printer resources using the communication device,” as claimed by Applicants in independent claim 26. The Office Action refers to Gacek, column 7, lines 52-54 for support with regard to this claim limitation. Applicants respectfully traverse this assertion and submit that the referenced language in Gacek discloses a preference directory 21 which stores information about the preferences and printing abilities of home users (Gacek, col. 7, lines 52-54). In this regard, Gacek does not teach or disclose “selecting a printer resource from the available printer resources using the communication device,” as claimed by Applicants in independent claim 26.

With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or suggest at least the limitation of "viewing printing parameters of the selected printer resource using the communication device," as claimed by Applicants in independent claim 26. The Office Action refers to Gacek, column 8, lines 13-18 for support with regard to this claim limitation. Applicants respectfully traverse this assertion and submit that the referenced language in Gacek discloses a printer driver to rasterize a print job within set-top box 10 (Gacek, col. 8, lines 13-18). In this regard, Gacek does not teach or disclose "viewing printing parameters of the selected printer resource using the communication device," as claimed by Applicants in independent claim 26.

With regard to the third criterion stated above and in reference to independent claim 26, Applicants submit that neither Gacek nor Parry disclose or suggest at least the limitation of "accepting the printer resource and the printing parameters using the communication device," as claimed by Applicants in independent claim 26. The Office Action refers to Gacek, column 7, lines 50-55 for support with regard to this claim limitation. Applicants respectfully traverse this assertion and submit that the referenced language in Gacek discloses preference directory 21, which stores information about the preferences and printing abilities of home users (Gacek, col. 7, lines 50-55). In this regard, Gacek does not teach or disclose "accepting the printer resource and the printing parameters using the communication device," as claimed by Applicants in independent claim 26.

Additionally, the Examiner states in the Office Action (pages 10-11) that Parry does not disclose "calling up printer resources available on the communication network using the communication device", "selecting a printer resource from the available printer resources using the communication device", "viewing printing parameters of the selected printer resource using the communication device", and "accepting the printer resource and the printing



parameters using the communication device,” as claimed by Applicants in claim 26. The Applicants respectfully agree.

Based on at least the foregoing, Applicants believe the rejection of independent claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Gacek has been overcome and request that the rejection be withdrawn.

Additionally, Applicants believe the rejection of dependent claims 27-28 under 35 U.S.C. § 103(a) as being anticipated over Parry in view of Gacek has been overcome and request that the rejection be withdrawn.

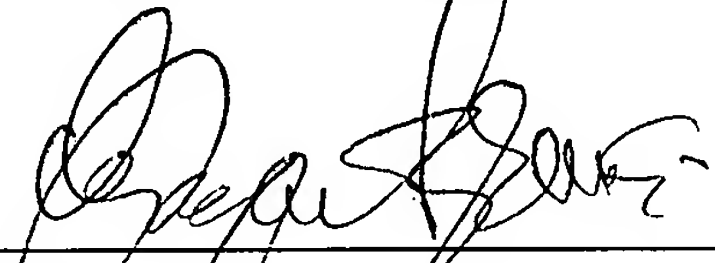
**CONCLUSION**

Based on the foregoing, Applicant believes that all claims 1-28 are in condition for allowance. If the Examiner disagrees, Applicant respectfully requests a phone interview, and requests that the Examiner telephone the undersigned at 312-775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,



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**AMENDMENTS TO THE DRAWINGS**

Three Replacement Sheets of drawings are attached hereto as Appendix A, following page 20 of this paper. The Replacement Sheets include amended FIGs. 1A - 1C, which replace originally submitted FIGs. 1A - 1C. Originally submitted FIGs. 1A - 1C have been amended to show correct item numbering, in accordance with the originally submitted detailed description of FIGs. 1A - 1C. Applicants submit that no new matter has been introduced by the amendments to FIGs. 1A - 1C.



## APPENDIX A